

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 2-20 are pending in the application, with claims 2, 8 and 14 being the independent claims.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Amendments to the Figures

Applicants have made minor amendments to FIGS. 6A and 6B to correct typographical errors. In particular, FIG. 6A (sheet 6 of the drawings) has been amended to correct a typographical error in the spelling of the word INDEPENDENT in block 630. FIG. 6B, (sheet 7 of the drawings) has been amended to correct a typographical error in the spelling of the word INDEPENDENT in sections 624, 626 and 628.

Each of the foregoing drawing amendments introduce no new matter, and their entry is respectfully requested.

Rejections under the judicially created doctrine of obvious-type double patenting

At paragraph 4 of the Office Action, the Examiner rejected claims 2-20 under the judicially created doctrine of obvious-type double patenting as being unpatentable over the

claims of U.S. Patent No. 5,737,624 to Garg *et al.* Applicants obviate the obviousness-type double patenting rejections based upon the terminal disclaimer submitted herewith.¹

Rejections under 35 U.S.C. § 102

At paragraph 7 of the Office Action, the Examiner rejected claims 2-20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,448,705 to Nguyen *et al.* (hereinafter, “the Nguyen reference”). As set forth below, Applicants submit that the Nguyen reference is not prior art under 35 U.S.C. § 102(e) because “one’s own invention whatever the form of disclosure to the public, may not be prior art against oneself, absent a statutory bar.” *In re Facius*, 408 F.2d 1396, 1406 (CCPA 1969).

First, Applicants note that the inventors in both the present application and the Nguyen reference were part of a project team at S-MOS Systems, Inc., that produced the “Seabird” architecture and subsequent chip implementation. The S-MOS “Seabird” architecture project produced the microprocessor architecture that is described in the Nguyen reference. The Nguyen reference describes and claims in part a method of operation in the overall “Seabird” microprocessor architecture.

As part of the “Seabird” project team, Applicants were responsible for the design of the Instruction Execution Unit (IEU). The Applicants’ IEU design is described generally in the Nguyen reference. The present application further describes the IEU, initially disclosed in the Nguyen reference, in greater detail to support the invention as claimed in the present application. Thus, the IEU disclosed in the Nguyen reference was invented by Applicants

¹ Applicants’ terminal disclaimer is also directed to prior U.S. Patent Nos. 5,497,499, 5,974,526, and 6,289,433, each of which shares a common specification with U.S. Patent No. 5,737,624.

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rather than the inventive entity listed on the Nguyen reference. The supporting declarations filed herewith set forth the facts as detailed above.² Applicants submit that these declarations provide a "satisfactory showing which would lead to a reasonable conclusion" that Applicants are the inventors of the claimed subject matter. *See* MPEP § 716.10 and *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982). For these reasons, Applicants request that the outstanding rejection of claims 2-20 under 35 U.S.C. § 102(e) be withdrawn.

² Filed herewith are true copies of original, signed declarations of Kevin Iadonato, Le Nguyen and Sanjiv Garg, which were filed in priority Appl. No. 08/594,401, now U.S. Patent No. 5,737,624, to overcome a like rejection under 35 U.S.C. § 102(e) over the Nguyen reference. All of the inventors are no longer employed by S-MOS Systems, Inc. The declaration of the remaining inventor, Johannes Wang, was never returned.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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